

Remarks

The examiner objected to claims 1, 2, 4, 19, 21 and 24-26 because of certain formalities. Applicant has made the amendments suggested by the examiner.

The examiner rejected claim 8 under 35 USC 112, second paragraph. Applicant has made the amendments suggested by the examiner.

The examiner rejected claims 26-33 under 35 USC 102(e) as being anticipated by Janky et al. (U.S. Patent Number 5,777,580). As part of this rejection, the examiner reasoned that Janky shows a controller 25 "configured . . . inherently, to put back to sleep (disable) the LDS receiver/processor 31 (location-signal-generating device) and the IS communications transmitter or responder means 27 (telemetry transmitter) after the IS communications transmitter or responder means 27 (telemetry transmitter) transmits the location signal." See page 5 (emphasis added).

Applicant respectfully traverses this rejection. Under the examiner's reasoning, claim 26 is anticipated only if it is inherent in Janky for the enable controller to disable the location-signal generating device and the telemetry transmitter after the telemetry transmitter transmits the location signal. This limitation is inherent in Janky only if the prior art in Janky necessarily includes the claimed limitations. See *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co., U.S.A. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746 (Fed. Cir. 1991) (emphasis added).

Thus, under the examiner's reasoning, the structure corresponding to the enable controller in Janky necessarily disables the location-signal generating device and the telemetry transmitter after the telemetry transmitter transmits the location signal. But that is not true. While Janky's enable controller may perform this function, "[i]nherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *Continental Can*, 948 F.2d at 1269 (citing *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (CCPA 1981)) (emphasis in original). For example, instead

of performing as the examiner suggests, the system in Janky may leave the telemetry transmitter system enabled after it transmits the location signal. It may continue to transmit the location signal continuously or periodically until it is unenabled by a person performing an action, such as removing power from the telemetry transmitter system, rather than such action being performed by the enable controller. Janky could be used in such a manner when the vehicle in which it is installed is stolen. In that situation, it might be useful to transmit the location signal on a continuous basis to allow the stolen vehicle to be continuously tracked. Thus, the enable controller in Janky does not necessarily disable the location-signal generating device and the telemetry transmitter after the telemetry transmitter transmits the location signal, as required by claim 26, and Janky does not inherently include this limitation.

Thus, Janky does not include this limitation either explicitly or inherently and, consequently, it does not anticipate claim 26. Claim 26 is patentable over Janky.

Claims 27-33 depend from claim 26 and are patentable for at least the same reasons.

The examiner rejected claims 1-11, 14, 16-22, 24 and 25 under 35 USC 103(a) as being unpatentable over Janky et al. (U.S. Patent Number 5,777,580) in view of Westerlage et al. (U.S. Patent Number 5,826,195). In rejecting claims 1-4, 19, 20 and 22, the examiner made essentially the same inherency argument as with claim 26: that Janky inherently shows "the controller 25 (enable controller) being configured to put back to sleep (disable, switch off) the LDS receiver/processor 31 (GPS receiver) and the IS communications transmitter or responder means 27 (cellular network transmitter)."

As discussed above with respect to claim 26, Janky does not inherently disclose this feature. The examiner implicitly admitted that Westerlage does not include this feature, which means that the examiner's proposed combination of Janky and Westerlage would not include this feature. Thus, claims 1-4, 19, 20 and 22 would not have been obvious to a person of ordinary skill at the time this application was filed over Janky in view of Westerlage. Thus, claims 1-4, 19, 20 and 22 are patentable over Janky in view of Westerlage.

Claims 3-11, 14, 16-18, 21 and 23-25 depend from one or more of claims 1-4, 19, 20 and 22, and are patentable for at least the same reasons.

Applicant contends that all of the claims are now in condition for allowance, which action is requested. Applicant does not believe any fees are necessary with this submission. Should any

fees be required, Applicant requests that the fees be debited from deposit account number 02-0383.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Howard Speight", is written over a horizontal line.

Howard L. Speight

Reg. No. 37,733

Baker Botts L.L.P.

910 Louisiana

Houston, Texas 77002

Telephone: (713) 229-2057

Facsimile: (713) 229-2757

ATTORNEY FOR APPLICANT

Date: September 12, 2001

Version With Markings to Show Changes Made

1. (twice amended) A triggerable location-reporting apparatus for use in an environment including: a source of **GPS Global Positioning Satellite System (GPS)** signals; a source of a trigger signal; a cellular base station connected through a network to a gateway; the cellular base station being configured to expect a Reverse Control Channel signal including a Mobile Identification Number and an Electronic Serial Number, the triggerable location-reporting apparatus ~~comprising~~ **comprising**:

- a GPS receiver responsive to the GPS signals for producing GPS data when enabled;
- a cellular network transmitter coupled to the GPS receiver for formatting and transmitting, when enabled, a Reverse Control Channel signal including a formatted GPS data in the place normally occupied by the Electronic Serial Number and a Mobile Identification Number that will cause the cellular base station to send a Registration Notification Invoke signal including the formatted GPS data to the gateway;
- a trigger signal receiver responsive to the trigger signal for producing an enable signal;
- an enable controller coupled to the GPS receiver, the cellular network transmitter, and the trigger signal receiver;
- the enable controller being configured to enable the GPS receiver and the cellular network transmitter upon receipt of the enable signal from the trigger signal receiver; and
- the enable controller being configured to disable the GPS receiver and the cellular network transmitter.

2. (amended) The triggerable location-reporting apparatus of claim 1 further comprising
a power supply connection;
a first switchable power signal coupled to the GPS receiver and the power supply connection;
a second switchable power signal coupled to the cellular network transmitter and the power supply connection.
3. (amended) The triggerable location-reporting apparatus of claim 2 where
the enable controller is configured to switch on and off the first switchable power signal and the second switchable power signal.
4. The triggerable location-reporting apparatus of claim 2 further comprising
a power supply coupled to the power supply connection.
5. The triggerable location-reporting apparatus of claim 4 wherein
the power supply comprises a battery.
6. The triggerable location-reporting apparatus of claim 4 wherein
the power supply comprises a solar cell.
7. The triggerable location-reporting apparatus of claim 4 wherein
the power supply comprises a vehicle battery.
8. (twice amended) The triggerable location-reporting apparatus of claim 1 wherein
the ~~page~~ trigger signal receiver, GPS receiver and ~~telemetry~~ cellular network transmitter are housed in a housing.
9. The triggerable location-reporting apparatus of claim 8 wherein
the housing is configured to be installed in a vehicle.

10. The triggerable location-reporting apparatus of claim 8 wherein the housing comprises at least a portion of an article of clothing.
11. The triggerable location-reporting apparatus of claim 8 wherein the housing is configured to be installed in an object to be tracked.
12. (cancelled) The triggerable location-reporting apparatus of claim 1 wherein the telemetry transmitter comprises a cellular telemetry transmitter.
13. (cancelled) The triggerable location-reporting apparatus of claim 1 wherein the telemetry transmitter comprises a satellite telemetry transmitter.
14. (amended) The triggerable location-reporting apparatus of claim 1 wherein the cellular network transmitter comprises a cellular telephone.
15. (cancelled) The triggerable location-reporting apparatus of claim 1 wherein the telemetry transmitter comprises a radio-telephone.
16. (amended) The triggerable location-reporting apparatus of claim 1 wherein the trigger signal comprises a page.
17. (amended) The triggerable location-reporting apparatus of claim 1 wherein the source of the trigger signal comprises an alarm.
18. (amended) The triggerable location-reporting apparatus of claim 1 wherein the source of the trigger signal comprises a remote control.

19. (twice amended) A method for reporting a location for an object in an environment including: a source of **GPS Global Positioning Satellite System (GPS)** signals; a source of a page including a command; a cellular base station connected through a network to a gateway; the cellular base station being configured to expect a Reverse Control Channel signal including a Mobile Identification Number and an Electronic Serial Number, the method **comprising** **comprising**:

receiving a page;

enabling, in response to the page, a GPS receiver responsive to the GPS signals to produce GPS data;

enabling, in response to the page, a cellular network transmitter to format and transmit a Reverse Control Channel signal including a formatted GPS data in the place normally occupied by the Electronic Serial Number and a Mobile Identification Number that will cause the cellular base station to send a Registration Notification Invoke signal including the formatted GPS data to the gateway; and

disabling the GPS receiver and the cellular network transmitter.

20. (amended) The method of claim 19

where enabling comprises applying power to a GPS receiver and a cellular network transmitter upon receipt of the page; and

where disabling comprises disconnecting power from the GPS receiver and the cellular network transmitter upon transmission of the location of the object.

21. The method of claim 19 further comprising

receiving the transmitted location at a gateway;

communicating the transmitted location to a service provider.

22. (amended) The method of claim 19 wherein transmitting comprises

transmitting the location of the object via the cellular network.

23. (cancelled) The method of claim 19 wherein transmitting comprises transmitting the location of the object via satellite telemetry.
24. The method of claim 19 further comprising determining if the object is moving; and continuing to transmit the location of the object while it is moving.
25. The method of claim 19 further comprising storing the location of the object; and transmitting the stored location of the object if the ability to determine location ceases.
26. (twice amended) A triggerable location-reporting apparatus comprising a location-signal generating device configured to produce a location signal when enabled; a telemetry transmitter coupled to the location-signal generating device configured to transmit the location signal when enabled; and ~~a~~ an enable controller configured to enable the location-signal generating device and the telemetry transmitter when it receives a trigger signal and to disable the location-signal generating device and the telemetry transmitter after the telemetry transmitter transmits the location signal.
27. The triggerable location-reporting apparatus of claim 26 wherein the location-signal generating device comprises a GPS processor.

28. (amended) The triggerable location-reporting apparatus of claim 27 where the controller comprises

a page receiver which produces an enable signal when it receives a page.

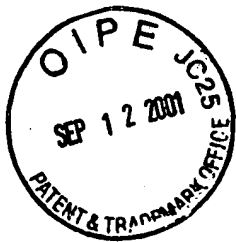
29. (amended) The triggerable location-reporting apparatus of claim 28 wherein the GPS processor generates the location signal in response to the enable signal.

30. The triggerable location-reporting apparatus of claim 28 wherein power is not applied to the GPS processor until the apparatus receives a page.

31. The triggerable location-reporting apparatus of claim 26 wherein power is not applied to the telemetry transmitter until the apparatus receives a page.

32. The triggerable location-reporting apparatus of claim 26 wherein the telemetry transmitter comprises a cellular telemetry transmitter.

33. The triggerable location-reporting apparatus of claim 26 wherein the telemetry transmitter comprises a satellite telemetry transmitter.



CERTIFICATE OF MAILING BY EXPRESS MAIL

PURSUANT TO 37 C.F.R. § 1.10, I HEREBY CERTIFY THAT THIS RESPONSE TO FINAL OFFICE ACTION DATED JULY 12, 2001 IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS EXPRESS MAIL POST OFFICE TO ADDRESSEE, IN AN ENVELOPE ADDRESSED TO:

HONORABLE COMMISSIONER OF PATENTS

BOX NON-FEE AMENDMENTS

WASHINGTON, D.C., 20231

ON SEPTEMBER 12, 2001.

DEBRA SPROUSE

SEPTEMBER 12, 2001

DATE

EL865848163US

EXPRESS MAIL LABEL

RECEIVED
SEP 19 2001
Technology Center 2600

INCLUDED IN THIS PATENT APPLICATION MAILING ARE:

RESPONSE TO FINAL OFFICE ACTION;

RETURN POSTCARD TO ACKNOWLEDGE RECEIPT OF ABOVE ITEMS.

ATTORNEY DOCKET NO.

069131.0102

FIRST NAMED INVENTOR:

ALVIN C. ALLEN, JR.

FILING DATE:

DECEMBER 7, 1998

TITLE:

"APPARATUS AND METHOD FOR TRIGGERABLE LOCATION
REPORTING"